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CHARLES N. QUINN FOX ROTHSCHILD LLP 2000 MARKET STREET, 10TH FLOOR PHILADELPHIA, PA 19103			SORKIN, DAVID L	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/066,338

Applicant(s)

MAGUIRE, STEPHEN B.

Examiner

David L. Sorkin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
- 4a) Of the above claim(s) 31-48, 53-67 and 83-96 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24, 27-30, 49-52 and 68-82 is/are rejected.
- 7) ☒ Claim(s) 25 and 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims 31-48, 53-67 and 83-96 drawn to an invention nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. There reasons for restriction are set forth in the previous office actions and are not repeated herein.

### ***Priority***

2. An amendment was received by the USPTO 27 May 2004, in which the specification is amended to claim priority to a provisional application.
3. Applicant alleges that a priority claim to the provisional application was claimed in the declaration filed 20 March 2002. However, the record does not reflect this. Applicant states that the priority claims was on page 2 of the declaration, and provides an alleged copy of the declaration in an 18 June 2004 communication. In the USPTO electronic application filed, the 20 March 2002 declaration skips from a page numbered "page 1" to a page number "page 3". No page having the priority claim was present in the file before the 27 May 2004 amendment.
4. 37 CFR 1.78(a)(5)(ii) states "...this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application...". The record does not reflect that applicant has complied with this rule. The examiner does not believe the examiner has the authority to waive this requirement.

5. Applicant must:
  - a. delete the claim for priority from the specification,
  - b. file a petition as set forth 37 1.78(a)(6), if applicable (that is, if the entire delay in filing the claim was unintentional); or
  - c. file some other type of petition that, if granted, would permit the examiner to accept the priority claim.
6. Additionally, the application No. "60/265,47" [sic] mentioned in the 27 May 2004 amendment apparently involves a typographic error and does not match the number in the alleged declaration copy filed 18 June 2004.

***Information Disclosure Statement***

7. As previously explained, the information disclosure statement filed 21 March 2003 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. Applicant alleges in remarks filed 25 October 2004: "A photocopy of that form PTO-1449 Modified is attached hereto". However, the USPTO file does not reflect receipt of any such form. Applicant further remarks "We respectfully request notification that this cures the problem with the 21 March 2003 Information Disclosure Statement". Since the form is not in the file the problem is not "cured". Furthermore, as explained in MPEP 609(III)(C)(1) "the date that the new IDS or correction is filed will be the date of the IDS for purposes of determining compliance with the requirements based on the time of filing the IDS".

**Specification**

8. The priority claim to provisional application No. "60/265,47" [sic] as objected to for the reason explained above.

**Claim Rejections - 35 USC § 102**

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 4, 5, 7, 8, 14, 16, 18-24, 27-29, 68-70, 72-74 and 77-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Siczek (US 3,957,399). Regarding claim 1, Siczek ('399) discloses an apparatus comprising a sealable container (10); a pump (15) within the container, having an inlet (18) proximate the container bottom; and a conduit (17) connected to an outlet of said pump and passing through said container to deliver pumped liquid at the container exterior. Regarding claim 4, while the reference states that the container may contain "paint" (see col. 3, lines 9-10), applicant is advised that "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* 136 USPQ 458,459 (CCPA 1963) and "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thilbault* 164 USPQ 666,667 (Bd. App. 1969). Regarding claim 5, the pump is a diaphragm pump (see title). Regarding claim 7, said pump is mechanically actuated (see col. 2, lines 5-6). Regarding claim 8, the pump is electrically power (see col. 2,

lines 59-61). Regarding claim 14, said pump further comprises a body (25,36) having a cavity formed therein; a cover (23) connector to said body; a flexible diaphragm (24) separating said cover from said cavity; said cover having a relief proximate the portion of said diaphragm separating said cover from said cavity, providing space between said cover and said diaphragm (see Fig. 5A); means for cyclically displacing said diaphragm away from said relief area of said cover and into said cavity (see col. 2 line 56 to col. 3 line 59); means for biasing (39) said diaphragm away from said cavity, towards said relief area of said cover and into said space during a portion of each cycle of diaphragm displacement. Regarding claim 16, said means for cyclically displacing is an elongated rod and moves axially reciprocally (see Fig. 2). Regarding claim 18, said means for cyclically displacing said diaphragm is a reciprocating means (see col. 2, lines 59-60). Regarding claim 19, said means for cyclically displacing said diaphragm is electrically driven (see col. 2, lines 59-61). Regarding claim 20, said means for cyclically displacing said diaphragm is mechanically driven (see col. 2, lines 5-6). Regarding claim 21, a portion of the reciprocating means (46) contacts said diaphragm. Regarding claim 22 said means for biasing is a spring (39). Regarding claim 23, the spring is a coil spring (see Fig. 2). Regarding claim 24, said body has an inlet passage (upward from 18 as seen in Fig. 2) connecting a pump exterior surface to said cavity, at least a portion of said passageway being substantially vertical, said pump comprising a first freely vertically movable ball (28) residing in said passageway vertical portion, for blocking liquid flow within said passageway and out of said pump. Regarding claim 27, said pump external surface is a bottom surface of said pump body (see Fig. 2). Regarding

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claim 28, the apparatus further comprises an outlet passageway (from 34 to 19) leading from a vertical extremity of said cavity to the exterior of said pump for conveyance of liquid displaced from said cavity by said diaphragm out of said pump. Regarding claim 29, the apparatus further comprises an outlet passageway (from 34-19) communicating with said cavity adjacent to said diaphragm and leading to the exterior of said pump for conveyance of liquid displaced from said cavity by said diaphragm out of said pump. Regarding claim 68, Siczek ('399) discloses an apparatus comprising a container (10); a rod (20 and in the alternative 42,43,46) reciprocally displaceable into said container (see col. 3, lines 12-15); and said container including a valve (28,30) opening to permit liquid flow from said container responsive to reciprocation of said rod. Regarding claim 69, said container is sealable (see col. 3, lines 1-3; Fig. 1). Regarding claim 70, while the reference states that the container may contain "paint" (see col. 3, lines 9-10), applicant is advised that "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* 136 USPQ 458,459 (CCPA 1963) and "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thilbault* 164 USPQ 666,667 (Bd. App. 1969). Regarding claim 72, the rod is mechanically actuated (see col. 2, lines 5-6). Regarding claim 73, said rod is electrically powered (see col. 2, lines 59-61). Regarding claim 74, a piston (20) is for drivingly reciprocating said rod (42,43,46). Regarding claim 77, said rod forms a part of a pump further comprising a body (23,25) within the container, having a cavity; a diaphragm (24) bounding a portion of said cavity; said rod providing means for

displacing said diaphragm at least part way into said cavity to displace liquid (see col. 3, lines 16-28); said diaphragm flexing away from said cavity during a portion of a rod reciprocation (see col. 3, lines 16-28). Regarding claim 78, said diaphragm flexes away from said cavity upon retracting movement of said rod relative to said diaphragm and cavity (see col. 3, lines 16-28; col. 5, lines 59-67). Regarding claim 79, said diaphragm resiliently self flexes away from said cavity upon retracting movement of said rod relative to said diaphragm (see col. 3, lines 16-59). Regarding claim 80, said diaphragm relaxes upon retracting movement of said rod relating to said cavity (see col. 3, lines 16-59). Regarding claim 81, said diaphragm relaxes upon retracting towards a position from which said rod displaces said diaphragm into said cavity (see col. 3, lines 16-59). Regarding claim 82, the apparatus further comprises means (39) for biasing said diaphragm towards a position from which said rod displaces said diaphragm into said cavity.

11. Claims 1-4, 6, 7, 11, 12, 23, 24, 27, 68-72 and 74-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Miner (US 2,606,696). Miner ('696) discloses an apparatus comprising a sealable container (T); a pump (11) within said container having an inlet (near 29, see Fig. 2) proximate the container bottom; and a conduit (12,12a) connected to an outlet (near 32, see Fig. 2) of said pump and passing through said container to deliver pumped liquid at the exterior of the container. Regarding claim 2, the apparatus further comprises self-sealing means (59,60,61,62,63) connected to said conduit at the exterior of said container for preventing flow of liquid out of said container via said conduit upon disconnection of said apparatus. Regarding claim 3, said self-



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sealing means is a spring (62) loaded manually actuable quick-disconnect. Regarding claims 4 and 9 applicant is advised that "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* 136 USPQ 458,459 (CCPA 1963) and "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thilbault* 164 USPQ 666,667 (Bd. App. 1969).

Regarding claims 6 and 11, the pump is pneumatically actuated (see col. 1, lines 4-6). Regarding claims 7 and 12, the pump is mechanically actuated (by rod 18). Regarding claim 23, said spring (62) is a coil spring (see Fig. 7). Regarding claim 24, said body has an inlet passage (28) connecting a pump exterior surface to said cavity, at least a portion of said passage way being substantially vertical (see Fig. 2), and said pump further comprising a first freely vertically movable ball (27) residing in said passageway vertical portion, for blocking liquid flow within said passageway and out of said pump. Regarding claim 27, said pump external surface is a bottom surface of said pump body. Regarding claim 68, Miner ('696) discloses an apparatus comprising a container (T), a rod (18) reciprocally displaceable into said container; and said container including a valve (27) opening to permit liquid flow from the container responsive to reciprocation of said rod. Regarding claim 69, said container is sealable (see Fig. 1). Regarding claim 70, applicant is advised that "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* 136 USPQ 458,459 (CCPA 1963) and "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus

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claim" *Ex parte Thilbault* 164 USPQ 666,667 (Bd. App. 1969). Regarding claim 71, said rod is pneumatically actuated (see col. 1, lines 4-6). Regarding claim 72, said rod is mechanically actuate (by piston 16). Regarding claim 74, a piston (16) for drivingly reciprocating said rod. Regarding claim 75, said piston is pneumatically actuated (see col. 1, lines 4-6). Regarding claim 76, said piston would be capable of being hydraulically actuated (see col. 1 line 50 to col. 2 line 22).

12. Claims 1, 4-6, 14, 15, 22-24 and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Poitras et al. (US 2,665,825). Poitras ('825) discloses an apparatus comprising a sealable container (10); a pump (20) within said container, having an inlet (35) proximate the container bottom; and a conduit (59,60,61) connected to an outlet (23) of the pump and passing through the container to deliver pumped liquid at the container exterior. Regarding claim 4, applicant is advised that "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* 136 USPQ 458,459 (CCPA 1963) and "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thilbault* 164 USPQ 666,667 (Bd. App. 1969). Regarding claim 5, the pump is a diaphragm pump (see col. 2, lines 44-54). Regarding claim 6, said pump is pneumatically actuated (see col. 2, line 26; col. 5, lines 30-35). Regarding claim 14, said pump further comprises a body (21); a cover connected to said body; a flexible diaphragm (33) separating said cover from said cavity, providing space between said cover and said diaphragm (see Fig. 2); means (70) for cyclically displacing said

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diaphragm away from aid relief area of said cover and into said cavity; means (55) for biasing said diaphragm away from said cavity, towards said relief area of said cover and into said space during a portion of each cycle of diaphragm displacement. Regarding claim 15, the means for cyclically displacing is pneumatically driven (see col. 2, line 26; col. 5, lines 30-35). Regarding claim 22, said means for biasing said diaphragm is a spring (55). Regarding claim 23, said spring is a coil spring (see Fig. 2). Regarding claim 24, said body has an inlet passageway (see Fig. 2) connecting a pump exterior surface to said cavity, at least a portion of said passageway being substantially vertical (see Fig. 2), and said pump further comprising a first freely vertically movable ball (38) residing in said passageway vertical portion, for blocking downward liquid flow within said passageway an out of said pump. Regarding claim 27, said pump external surface is the bottom of the pump (see Figs. 1 and 2). Regarding claim 28, an outlet passage (23) leads from a vertical extremity of said cavity to the exterior of said pump.

Regarding claim 29, an outlet passage (23) communicates with said cavity adjacent said diaphragm and leads to the exterior of said pump. Regarding claim 30, the outlet passageway has a vertical portion (see Fig. 2) and the pump has a first freely vertically movable ball (45) residing in said outlet passageway vertical portion, for blocking downward liquid flow within said outlet passageway of the pump.

13. Claims 1-16, 18-23, 49, 50, 68-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Conover (US 2,656,828). Regarding claim 1, Conover ('828) discloses an apparatus comprising a sealable container (30), a pump (see col. 3, lines 44-59), having an inlet (55,56) proximate the container bottom; and a conduit (34,63) connected

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to an outlet (50) of said pump and passing through said container to deliver pumped liquid at the container exterior. Regarding claim 2, the apparatus further comprises self-sealing means connected to said conduit at the exterior of said container for preventing flow of liquid out of said container via said conduit upon disconnection of said apparatus (see col. 5 line 48 to col. 6 line 41; Figs. 8 and 10). Regarding claim 3, said self-sealing means is a spring loaded manually actuatable quick-disconnect (see col. 5, line 48 to col. 6 line 41; Figs. 8 and 10). Regarding claims 4 and 9, applicant is advised that "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* 136 USPQ 458,459 (CCPA 1963) and "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thilbault* 164 USPQ 666,667 (Bd. App. 1969). Regarding claims 5 and 10, the pump is a diaphragm pump (see col. 3, lines 44-59). Regarding claims 6-8 and 11-13, these claims discuss the manner in which the pump is intended to be operated. Applicant is advised that "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* 152 USPQ 235 (CCPA 1967). In this instant the reference discloses the act of actuating the pump by manually depressing the piston shaped handle (58); however part 58 would be capable of being depressed by other sources of force. Regarding claim 14, the pump further comprises a body (46) having a cavity formed therein; a cover (45) connected to the body; a flexible diaphragm (47) separating said cover from said cavity, providing space between said cover and said diaphragm; means (58,57) for cyclically displacing said

diaphragm away from said relief area of said cover and into said cavity; means (59) for biasing said diaphragm toward said relief area of said cover and into said space during a portion of each cycle of diaphragm displacement. Regarding claim 15, as explained above with regard to claims 6 and 11, the means (58,57) would be capable of being pneumatically driven. Regarding claim 16, said means for cyclically displacing said diaphragm is an elongated rod (57) and moves axially reciprocally. Regarding claims 18, said means (58,57) is a reciprocating means (see col. 3 line 60 to col. 4 line 23). Regarding claims 19 and 20, as explained above regarding claims 7, 8, 12 and 13, the means (58,57) could be driven mechanically or electrically. Regarding claim 21, the reciprocating means (58,57) contacts the diaphragm (see Fig. 3). Regarding claim 22, said means for biasing is a spring (59). Regarding claim 23, the spring is a coil spring (see Fig. 3). Note: means for pumping of claim 49 and pumping means of claim 51 are not considered to invoke section 112 sixth paragraph because the three-prong test set forth in MPEP 2181 (page 2100-214 of the Feb. 2003 edition), specifically "the phrase 'means for' or 'step for' must not be modified by sufficient structure, material or acts for achieving the specified function". Regarding claim 49, Conover ('828) discloses a container (30) having a quick disconnect fitting for output of liquid (see col. 5, line 48 to col. 6 line 41; Figs. 8 and 10); means within said container, for pumping liquid out of said container responsive to pressurized gas furnished thereto (see col. 2 line 54 to col. 3 line 6) comprising an upper portion (45); a body portion (46) connected to said upper portion, having an open interior cavity facing said upper portion, a liquid inlet facing communicating with said open interior cavity and an outlet also communicating with said

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inlet (see Fig. 3); a check valve (53) within said inlet for permitting inflow of liquid from within said container into said open interior cavity but blocking outflow from said open interior cavity into said container; a diaphragm (47) between said upper portion and said open interior of said body, edges of said diaphragm being sandwiched between said upper portion and said body, being distendable towards and into said open interior cavity of said body responsively to application of force to a diaphragm side facing oppositely from said open interior cavity to displace liquid having entered said open interior cavity to displace liquid having entered said open interior of said body through said inlet orifice from said body through said outlet and out of said container via an outlet connection by urging a diaphragm surface facing said open interior cavity of said body against liquid present therein (see col. 3, line 44 to col. 4 line 23); and a spring (59) for biasing said diaphragm away from said open interior. Regarding claim 50, applicant is advised that "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto supra.* and "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thilbault supra.* Regarding claim 68, Conover ('828) discloses an apparatus comprising a container (30), a rod (57) reciprocably displaceable into said container; and said container including a valve (53) opening to permit liquid color flow from said container responsively to reciprocation of said rod. Regarding claim 69, said container is sealable (see col. 2, line 54). Regarding claim 70, applicant is advised that "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the

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claims" *In re Otto supra.* and "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thilbault supra.* Regarding claim 71-73, 75 and 76 as explained above regarding claims 6-8, the rod and piston would be capable of being pneumatically, hydraulically, electrically, or mechanically actuated. Regarding claim 74, a piston (58) is for drivingly reciprocating said rod. Regarding claim 77, said rod forms part of a pump further comprising a body (46) having a cavity formed therein; a diaphragm (47) bounding a portion of said cavity; said rod providing means for displacing said diaphragm at least part way into said cavity to displace liquid therefrom; said diaphragm flexing away from said cavity during a portion of a rod reciprocation (see Fig. 3; col. 3, line 44 to col. 4 line 23). Regarding claim 78, said diaphragm flexes away from said cavity upon retracting movement of said rod relative to said diaphragm and said cavity (see Fig. 3; col. 3, line 44 to col. 4 line 23). Regarding claim 79, said diaphragm resiliently self-flexes away from said cavity upon retracting movement of said rod relative to said diaphragm (see col. 3, line 44 to col. 4 line 23). Regarding claim 80, said diaphragm relaxes upon retracting movement of said rod relating to said cavity (see col. 3, line 44 to col. 4 line 23). Regarding claim 81, said diaphragm relaxes upon retracting movement of said rod away from said diaphragm (see col. 3, line 44 to col. 4 line 23). Regarding claim 82, means (59) biases said diaphragm towards a position from which said rod displaces said diaphragm into said cavity (see col. 3, line 44 to col. 4 line 23).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Poitras et al. (US 2,665,825) in view of Hampton (US 1,489,348). The apparatus of Poitras ('825) was discussed above with regard to claim 14. In Poitras ('825), the means for cyclically displacing is a pneumatic pressure generating device (70), rather than means meeting the limitations of claim 16-19. Hampton ('348) teaches means for cyclically displacing a diaphragm of a pump which move rotatably about an axis (see rotatable cams 112, 149, 168), which may be electrically driven (see page 10 line 79-80), and which includes a reciprocating member (111 in the embodiment of Fig. 4, 106 in Fig. 6). It is considered that it would have been obvious to one of ordinary skill in the art to have provided that apparatus of Poitras ('825) with the electrically driven, rotatable cam/ reciprocating plunger means of Hampton ('348) because Hampton ('348) explicitly presents such means as an alternative to pneumatic pressure displacement in diaphragm pumps (see page 10 lines 34-88).

16. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siczek ('399) in view of Hampton (US 1,489,348). The apparatus of Siczek ('399) was discussed above with regard to claim 14. Siczek ('399) discloses a "reciprocating electric motor" in col. 2, lines 59-68, but does not detail its construction. Hampton ('348)



teaches means for cyclically displacing a diaphragm of a pump which move rotatably about an axis (see rotatable cams 112, 149, 168), which may be electrically driven (see page 10 line 79-80), and which includes a reciprocating member (111 in the embodiment of Fig. 4, 106 in Fig. 6). It is considered that it would have been obvious to one of ordinary skill in the art to have provided that apparatus of Siczek ('399) with the electrically driven, rotatable cam/ reciprocating plunger means of Hampton ('348) because Hampton ('348) provides a more detailed description consistent with the type of motor Siczek ('399) suggest, for the same purpose (reciprocating a diaphragm of a diaphragm pump). The word "revolutions" in Hampton ('348) would have also suggested means rotating about an axis.

17. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conover ('828) in view of Hampton (US 1,489,348). The apparatus of Conover ('828) was discussed above with regard to claim 14. Conover ('828) does not disclose rotatable means for cyclically displacing. Hampton ('348) teaches means for cyclically displacing a diaphragm of a pump which move rotatably about an axis (see rotatable cams 112, 149, 168) and which includes a reciprocating member (111 in the embodiment of Fig. 4, 106 in Fig. 6). It is considered that it would have been obvious to one of ordinary skill in the art to have provided that apparatus of Conover ('828) with the rotatable cam/reciprocating plunger means of Hampton ('348) because Hampton ('348) explicitly presents such means as an alternative other manners in which to cause displacement of a diaphragm of a pump (see page 10 lines 34-88).

18. Claims 51 and 52 rejected under 35 U.S.C. 103(a) as being unpatentable over Conover (US 2,656,828) in view of Miner (US 2,606,696). Regarding claim 51, Conover ('828) discloses an apparatus comprising a container (30) having an outlet connection (see col. 5 line 47 to col. 6 line 41; Figs. 8 and 10); a reciprocable rod (57) within said container; diaphragm pump means housed at least partially within said container, for pumping liquid out of said container via said outlet connection comprising an upper housing part (45) having a relief with an aperture therein (see Fig. 3; col. 3 line 44 to col. 4 line 23); a body (46) connected to said upper housing part and having an open interior cavity facing said relief of said upper housing part, said body having a liquid inlet aperture communicating with said open interior cavity an outlet aperture communicating with said open interior remotely from said inlet aperture (see Fig. 3; col. 3 line 44 to col. 4 line 23); a check valve (53) at said inlet aperture for permitting inflow of liquid from within said container into said open interior cavity but blocking efflux of said liquid outwardly from said open interior cavity through said inlet aperture; a diaphragm (47) between said upper housing part and said open interior cavity of said body, being distendable towards and into said open interior cavity of said body responsively to axial reciprocating movement of said rod through said aperture in said relief of said upper housing part to serially displace liquid in said open interior cavity from said body through said outlet orifice and out of said container via said outlet connection (see Fig. 3; col. 3 line 44 to col. 4 line 23); and a spring (59) for biasing said diaphragm away from said open interior portion of said body and into space proximate said relief. The rod (57) of Conover ('828) is connected to piston (58), which is intended to be manually actuated.

The claimed "pneumatic piston-cylinder combination" is not disclosed by Conover ('828). Miner ('696) taught a pneumatic piston-cylinder combination (14,16) removably connected to a container (T), for providing pneumatically driven reciprocation of an output shaft portion (a portion of 18) thereof. It is considered that it would have been obvious to one of ordinary skill in the art to have provided the apparatus of Conover ('828) with the pneumatic piston-cylinder combination of Miner ('696), because Miner ('696) explains that the purpose of this aspect of his invention is to automate hand operated pumps (see col. 3, lines 18-20), while the pump of Conover ('828) is hand operated. Regarding claim 52, applicant is advised that "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto supra*. and "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thilbault supra*.

#### ***Allowable Subject Matter***

19. Claims 25 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

20. The claims as currently amended are not rejected under section 112.

21. Applicant has declined to traverse the rejection under section 102(b) of claims 1-4, 6, 7, 11, 12, 23, 24, 27, 68-72 and 74-76 as being anticipated by Miner (US 2,606,696). Applicant should cancel these admittedly unpatentable claims.

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22. Applicant has declined to traverse the rejection under section 102(b) of claims 1, 4-6, 14, 15, 22-24 and 27-30 being anticipated by Poitras et al. (US 2,665,825).

Applicant should cancel these admittedly unpatentable claims.

23. Applicant has declined to traverse the rejection under section 102(b) of claims 1-16, 18-23, 49, 50, 68-82 as being anticipated by Conover (US 2,656,828). Applicant should cancel these admittedly unpatentable claims.

24. Applicant has declined to traverse any of the section 103(a) rejections of claims 16-19, 51 and 52. Applicant should cancel these admittedly unpatentable claims.

25. While applicant does generally traverse the rejection under section 102(b) of claims as being anticipated by Siczek (US 3,957,399), applicant does not refer to any particular claim. Applicant does not even attempt to point out any claimed element or arrangement of elements which the reference fails to disclose.

### ***Conclusion***

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 571-272-1148. The examiner can normally be reached on 9:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David L. Sorkin  
Primary Examiner  
Art Unit 1723

David Sorkin